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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,732	12/21/2000	Waldemar Kiener	(K) 54 039	6906

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EXAMINER

GOFF II, JOHN L

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 03/31/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,732

Applicant(s)

KIENER ET AL.

Examiner

John L. Goff

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 1/17/03 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to Paper No. 10 filed on 1/17/03.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 1/17/03 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Patent and Trademark Office no longer prepares new drawings. The correction to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuhaus et al. (U.S. Patent 4,389,472) in view of Ueda et al. (EP 726142) and the admitted prior art (Specification pages 1-2).

Neuhaus et al. are directed to a method of forming tamperproof documents (documents that cannot be falsified such as credit cards, company cards, etc.) by laminating an information carrier with a plastic foil on one or both sides wherein the plastic foil has an adhesive layer that is hardened by UV radiation (Column 1, lines 5-7 and 53-66 and Column 7, lines 33-35 and Column 12, lines 31-37). Neuhaus et al. teach an information carrier (the carrier may include a photo-polymer film) continuously laminated on one or both sides with a plastic foil (the foil includes a layer of UV curable adhesive) to form a laminate (Column 10, lines 30-43 and Column 11, lines 17-26). The laminate is then exposed to UV radiation to cure the adhesive (Column 11, lines 53-56). Neuhaus et al. teach that the plastic foil is fed from a supply roll, the foil may be comprised of polyethylene, the foil is subjected to a corona discharge prior to lamination, and the laminate may be cut from the continuous supply after lamination (Column 9, lines 49-50 and Column 10, lines 3-10 and Column 11, lines 28-36). Neuhaus et al. are silent as to using an information carrier provided on each side with a protective film (supporting film). However, it is known in the art that to provide a protective film on one or both sides of the information carrier during manufacturing as shown by the admitted prior art and Ueda et al. Furthermore, it is known in the art to remove the protective film prior to applying the carrier to a substrate as shown by the admitted prior art and Ueda et al. One of ordinary skill in the art at the time the invention was made reading Neuhaus et al. in view of the admitted prior art and Ueda et al. would have readily appreciated incorporating into Neuhaus et al. an information carrier with a

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protective film provided on one or both sides wherein the film is removed prior to processing as suggested by the admitted prior art and Ueda et al. as only the expected results would be achieved, i.e. the information carrier would be protected from contamination prior to its application in a forgery-proof document.

The admitted prior art is directed to known processes for producing forgery proof documents. The admitted prior art teaches that information carriers comprising polymer films are provided with protective films (supporting films) on both sides during their production (Specification page 2, lines 1-5). The admitted prior art teaches that removing the protective films prior to processing into forgery proof documents was known at the time the invention was made due to the high processing temperatures of the films (Specification page 2, lines 7-13). Ueda et al. are directed to a method for producing a photosensitive film laminate that includes a hologram. Ueda et al. teach providing the photosensitive film with a protective film (Figure 6b and Column 8, lines 31-36). Ueda et al. teach that the protective film is removed from the laminate prior to applying the hologram on a substrate (Column 9, lines 31-38).

Regarding claims 1 and 2, it would have been within the purview of one of ordinary skill in the art at the time the invention was made to process each side of the film separately (removing the protective film from one side of the information carrier prior to applying a polymer film with a layer of UV curable adhesive and then removing the protective film from the other side of the information carrier prior to applying a polymer film with a layer of UV curable adhesive to that side of the information carrier as shown in Figure 2) or together (remove both protective films prior to applying both polymer films each including a layer of UV curable

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adhesive as shown in Figure 3) as only the expected results would be achieved, i.e. the same product would be produced.

Regarding claims 5 and 6, the use of a roller to transport the laminate during curing wherein the laminate is wrapped around the roller by at least 180° is known in the art as shown by Ueda et al. (35 of Figure 6a), and one of ordinary skill in the art at the time the invention was made would have readily appreciated using the roller to transport the laminate as only the expected results would be achieved.

6. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuhaus et al, the admitted prior art, and Ueda et al. as applied above in paragraph 5, and further in view of Butler et al. (U.S. Patent 3,822,838).

Neuhaus et al., the admitted prior art, and Ueda et al. teach all of the limitations in claims 11 and 12 except for a teaching on using a splicer and a storage device to ensure the continuous supply of photo-polymer (information carrier) film. It is noted, Ueda et al. teach forming the photo-polymer film on a supply roll (43 of Figure 6a). Butler et al. are directed to an apparatus for providing an uninterrupted supply of a web material from a supply roll to a machine that consumes the web at a high speed (Column 1, lines 7-10). Butler et al. teach that the apparatus comprises a splicer to automatically splice in a new roll when the running roll is depleted and an accumulator to ensure the web is continuously supplied to the web consuming machine when a new roll is being spliced (Figure 1 and Column 1, lines 10-21). One of ordinary skill in the art at the time the invention was made would have readily appreciated incorporating into the method taught by Neuhaus et al. as modified by the admitted prior art and Ueda et al. the splicer and storage device taught by Butler et al. to ensure a continuous supply of photo-polymer film.

Response to Arguments

7. Applicant's arguments filed 1/17/03 have been fully considered but they are not persuasive. Applicant argues the laminate produced by Neuhaus et al. is the final product, and this is in contrast to applicant's invention which produces a laminate suitable for further processing for forgery-proof documents. It is noted Neuhaus et al. teach that after forming the continuous laminate the laminate may be cut into individual pieces (Column 11, lines 29-36), and thus, Neuhaus et al. teach further processing of the laminate for forgery-proof documents. Also, one of ordinary skill in the art would have readily appreciated that the laminate taught by Neuhaus et al. would undergo processing steps such as embossing, packing, shipping, etc. which would all meet the limitation of further processing. Furthermore, it is noted claims 1 and 2 are directed to a "Process for producing a laminate, comprising at least one polymer film with information and at least one substrate, for further processing for forgery-proof documents". It is noted the preamble of claims 1 and 2 teach making a laminate, and the laminate is capable of undergoing further processing for forgery-proof documents. However, claims 1 and 2 do not specifically recite any further processing steps within the main body of the claim nor do they specifically recite in the main body of the claim that after forming the laminate the laminate undergoes further processing for forgery-proof documents. Therefore, "for further processing for forgery-proof documents" only suggests the laminate is capable of undergoing further processing, and as shown above, the laminate taught by Neuhaus et al. is capable of undergoing such processing. As to applicants' arguments with respect to Ueda et al., it is noted Ueda et al. is not cited to teach applicant's complete process. Ueda et al. is cited only to show it was known in the art that when manufacturing an information carrier such as that used in Neuhaus et al. it was

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known to provide a protective film on one or both sides of the carrier, and further it was known to remove the protective film prior to applying the carrier to a substrate. These teachings are further shown in the admitted prior art wherein Ueda et al. is also referred to.

It is noted the previous office action in paragraph 7 the heading referred to claims 10 and 11. However, this was a mistake, and the heading should have referred to claims 11 and 12 as the content of the rejection was directed to claims 11 and 12.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **703-305-7481**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

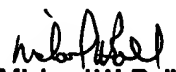
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



John L. Goff
March 27, 2003



Michael W. Ball
Supervisory Patent Examiner
Technology Center 1700